

DEC 8 1995

No. 95-26

CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN, *et al.*,
v. *Petitioners,*

WESTVIEW INSTRUMENTS, INC., *et al.*,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF AMICUS CURIAE OF
UNITED STATES SURGICAL CORPORATION
IN SUPPORT OF RESPONDENTS**

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QUESTION PRESENTED

"[T]he specific question at issue here [is] whether judges or juries should interpret patents." Pet. Br. at 30.

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INTEREST OF THE AMICUS

Amicus, a manufacturer of surgical equipment, was plaintiff in a patent infringement suit in which the trial court submitted the issue of claim construction for the jury to decide with the aid of a copy of *Webster's New World Dictionary* in the jury room. *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081 (petition for certiorari pending).¹

SUMMARY OF ARGUMENT

Petitioners seek a massive overruling. They are asking this Court not just to reverse a decision of eight judges of the full bench of the Federal Circuit, but also to disapprove an unbroken line of this Court's own cases that reaches back before the Civil War. Those decisions have been firmly established, have worked well, and have been reaffirmed often for over a century. Repeatedly this Court has held, and lower courts and treatise writers for over a century have recognized, that construction of patent claims is an issue of law to be decided by the court. *E.g.*, *Winans v. Denmead*, 15 How. 330 (1854).

There is no dispute in this case that jury trial is available in patent-infringement actions. All parties agree that it is. The issue instead concerns allocation of functions in a jury trial. Although petitioners state "the specific question at issue here" as "whether judges or juries should interpret patents," Pet. Br. 30, they also say that "[w]here the terms themselves are clear without resorting to extrinsic evidence, there is simply no genuine interpretive dispute for the jury to decide." *Id.* at 35; see also Litton Br. 10. *Amicus* Exxon acknowledges that "courts have traditionally viewed claim construction as raising, in an overall sense, a legal question . . . claim construction is ultimately a question of law." Exxon Br. 3, 10.

However, petitioners say, if the judge for help in understanding terminology of the claim consults sources extrinsic to the patent document itself—in particular, if the

¹ Petitioners and respondents have consented to the filing of this brief; their letters to that effect have been lodged with the Clerk.

judge hears expert testimony—then the construction of the claim is transformed into an issue that the jury, not the judge, is required by the Seventh Amendment to decide.

Petitioners assert that the decision under review here “uprooted the landscape.” Pet. Br. 14. Quite the opposite. And the constitutionally grounded need for certainty and understandable limits on patent claims—which many cases recognize never could be maintained if claims were construed by varying juries—confirms the soundness of a century and a half of this Court’s holdings.

ARGUMENT

I. FOR A CENTURY AND A HALF, THIS COURT REPEATEDLY HAS HELD THAT PATENT CLAIM CONSTRUCTION IS FOR THE COURT.

A. This Court’s Decisions Are Clear.

It would be difficult to imagine a more clear-cut statement of the allocation of responsibilities in a patent-infringement case than what this Court through Justice Curtis held in 1854 in *Winans v. Denmead*, 15 How. 330:

“On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants.

“*The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them.* The second is a question of fact, to be submitted to a jury.”

15 How. at 338 (emphasis supplied).²

² Justice Curtis had been a practitioner of patent law. His brother, the author of the leading treatise on the subject, wrote that Justice Curtis at law school was “among the studious young men of talent who first gathered about Judge Story,” and “[t]he practice on which he entered in Boston . . . made him familiar with the patent law, for which his mental characteristics gave him a singular adaptation.” 1 A. MEMOIR OF BENJAMIN ROBBINS CURTIS, LL.D. v. 42-43, 84 (B. Curtis ed. 1879); cf. *O’Reilly v. Morse*, 15 How. 62, 63 (1853) (Justice Curtis, “having been of counsel, did not sit” in case involving patent on the telegraph).

The rule recognized so plainly in *Winans v. Denmead* had been previously announced on several occasions, going all the way back to judges who lived in the time of the adoption of the Seventh Amendment. In *Davis v. Palmer*, 7 Fed. Cas. 154 (C.C.D. Va. 1827) (No. 3,645), Chief Justice Marshall rejected the contention that the jury should construe a patent:

“Will it be said that it may be left to the jury to determine, what is ‘about’ the proportion particularly designated? This expedient will not remove the difficulty. We doubt how far it may consist with the principle that the court is to construe every written instrument. But, waiving this doubt, if the word has any limits, they must always be the same.”

7 Fed. Cas. at 158. This Court itself construed the scope of patent grants at least as early as *Evans v. Eaton*, 3 Wheat. 454, 512-15 (1818).³

In *Silsby v. Foote*, 14 How. 218 (1852), decided two years before *Winans v. Denmead* and also written by Justice Curtis, this Court had affirmed that “[t]he construction of the [patent] claim was undoubtedly for the court.” 14 How. at 225. The jury, in contrast, would decide whether particular parts challenged as infringing actually came within the definition given to the jury by the court. “[T]o this extent, not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury.” 14 How. at 226. Thus before the turn of this century this Court summarized:

“The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol. 3, page 378, as follows: ‘Where the defence denies that the invention used by the defendant is identical with that

³ For other early examples in which judges construed patents, often in jury charges, all by Justice Washington, see, e.g., *Pennock v. Dialogue*, 19 Fed. Cas. 171, 173 (C.C.E.D. Pa. 1825) (No. 10,941), *aff’d*, 2 Pet. 1 (1829); *Kneass v. Schuylkill Bank*, 14 Fed. Cas. 746, 748 (C.C. Pa. 1820) (No. 7,875); *Pettibone v. Derringer*, 19 Fed. Cas. 387, 389 (C.C.D. Pa. 1818) (No. 11,043); *Gray v. James*, 10 Fed. Cas. 1015, 1017 (C.C.D. Pa. 1817) (No. 5,718). See also n. 5, *infra*.

included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.' "

Coupe v. Royer, 155 U.S. 565, 579 (1895), quoting 3 W. ROBINSON, PATENTS 378 (1890). For examples of this Court itself construing patent claims, see, e.g., *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 237 (1942); *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 368 (1942); *Smith v. Snow*, 294 U.S. 1, 7 (1935) ("The question presented here is what scope may rightly be given to Claim 1 of the patent"); *McClain v. Ortmyer*, 141 U.S. 419, 423-25 (1891); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 275 (1877); *Rubber Co. v. Goodyear*, 9 Wall. 788, 796 (1870).

Petitioners propose that this Court's constant reaffirmations that claim construction is a matter of law should all be reinterpreted as in effect summary-judgment resolutions, simply because in some instances this Court remarked that the interpretation of the claim was not difficult. Pet. Br. 34.⁴ That was not the understanding at all. *Parker v. Hulme*, 18 Fed. Cas. 1138, 1140 (C.C.E.D. Pa. 1849) (No. 10,740), a leading case, summarized:

"The specification, being an instrument of writing, and the words of which it is made up having a fixed and plain import, its interpretation is a matter exclusively for the court, who must explain it. This part of the case is not for the jury, who, for the purposes of this cause, will adopt and act upon the interpretation given to it by the court. There is great reason and importance for this distribution of

⁴ Such judicial comments are not uncommon in many contexts. E.g., *Barron v. Baltimore*, 7 Pet. 243, 247-48 (1833) ("The question thus presented is, we think, of great importance, but not of much difficulty"); *Catalin Corp. v. Catalazuli Mfg. Co.*, 79 F.2d 593, 597 (2d Cir. 1935) (L. Hand, J.) ("The defendant's fanciful interpretation has no support in the specifications and contradicts their natural implication").

the respective duties of the court and the jury. The import of the instrument is purely a question of law."⁵

The "doctrine of the cases" referred to in *Coupe v. Royer* has been followed countless times throughout the Twentieth Century. See, e.g., *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822 (Fed. Cir. 1992) (noting that *Winans v. Denmead* "mandates" that court construe patent claims). A few recent deviant decisions, which confused the jury's role in deciding infringement with the judge's in construing claims, were disapproved by the *en banc* court here.

Moreover, the Seventh Amendment looks to what courts, attorneys and scholars understood the law to be; not whether with retrospective ingenuity petitioners can find ways to recharacterize long-established holdings as dicta. The leading early treatise, by Justice Curtis'

⁵ Petitioners and the dissent misunderstand *Washburn v. Gould*, 29 Fed. Cas. 312 (C.C.D. Mass. 1844) (No. 17,214). That opinion referred to a then-recent English opinion on juries construing terms of art to determine whether a specification was adequate, see pp. 24-25, *infra*; in the sentences that immediately follow the portion quoted at P.C.A. 105a and Pet. Br. 27, Justice Story explained:

"But I do not proceed upon this ground. The court did explicitly give to the jury its construction of the patent in the present case . . ."

29 Fed. Cas. at 325. The jury based on the instruction would decide, he said, what parts were novel. *Id.* For other examples in which Justice Story construed patents as a matter of law, see *Prouty v. Draper*, 20 Fed. Cas. 11, 12 (C.C.D. Mass. 1841) (No. 11,446), *aff'd*, 16 Pet. 336 (1842); *Stone v. Sprague*, 23 Fed. Cas. 161 (C.C.D.R.I. 1840) (No. 13,487); *Blanchard v. Sprague*, 3 Fed. Cas. 648, 650 (C.C.D. Mass. 1839) (No. 1,518); *Ryan v. Goodwin*, 21 Fed. Cas. 110, 112 (C.C.D. Mass. 1839) (No. 12,186); *Ames v. Howard*, 1 Fed. Cas. 755, 756-57 (C.C.D. Mass. 1833) (No. 326); *Barrett v. Hall*, 2 Fed. Cas. 914, 925 (C.C.D. Mass. 1818) (No. 1,047); *Whittemore v. Cutter*, 29 Fed. Cas. 1120, 1123 (C.C.D. Mass. 1813) (No. 17,600). Cf. A. WALKER, TEXT-BOOK OF THE PATENT LAWS 417 (4th ed. 1904), cited at Litton Br. 17 n.26, which similarly refers "question[s] of the prior art" to the jury, but reiterates that "Questions of construction are questions of law for the judge, not questions of fact for the jury." *Id.* at 183.

brother, observed that the extent of a patent claim "is universally a question for the court." G. CURTIS, PATENTS 19 (2d ed. 1854); *accord*, A. WALKER, TEXT-BOOK OF THE PATENT LAWS 133 (1887) ("Questions of construction are questions of law for the judge, not questions of fact for the jury"). Professor William C. Robinson, after reviewing every available English and American patent decision up to 1882, concluded:

"The duty of interpreting letters-patent has been committed to the courts. A patent is a legal instrument, to be construed, like other legal instruments, according to its tenor. . . . Where technical terms are used . . . the testimony of witnesses may be received upon these subjects, and any other means of information be employed. But in the actual interpretation of the patent the court proceeds upon its own responsibility as an arbiter of the law, giving to the patent its true and final character and force."

2 W. ROBINSON, *supra*, at 481-83; see 1 *id.* at vi; ⁶ see also, e.g., B. STEDMAN, PATENTS 540 (1939) ("The court defines the patented invention as indicated by the language of the claims").⁷

⁶ See also Story, *On the Patent Laws*, 3 Wheat. app. 13, 18 (1818) ("the court will construe the terms of the patent and of the specification, in a liberal manner"). Professor Robinson in a passage incompletely quoted at Litton Br. 17 said that when a claim was challenged as invalid for ambiguity ("the fourteenth defence"), the court as a matter of "judicial discretion" might elect to refer fact issues outside the claim to a jury. 3 ROBINSON at 299-300. But "the court interprets the Claim so far as it is capable of an interpretation . . . the jury follow this interpretation." *Id.* at 377. The "instructions on this point control the jury." *Id.* at 378 n.13. Most importantly, when as here the issue is whether a defendant's device infringes a plaintiff's patent ("the eighteenth defence"), "the court defines the patented invention as indicated by the language of the Claims; the jury judge whether the invention so defined covers the art or article employed by the defendant." *Id.* at 378.

⁷ That Congress several times reenacted the patent laws with this settled law so well established is of course persuasive as to what those laws intend. *Cf.*, e.g., *Keene Corp. v. United States*, 113 S. Ct. 2035, 2043 (1993); *Lorillard v. Pons*, 434 U.S. 575, 580 (1978); *Albemarle Paper Co. v. Moody*, 422 U.S. 405, 418 n.8 (1975).

B. Assistance of Experts Does Not Alter the Court's Role.

Faced with these decisions, petitioners urge that the recognized rule should not apply if the court interpreting a patent claim consults materials outside the language of the document itself. Pet. Br. 35. But that is a *non sequitur*. Judges often consult outside materials of all kinds and even hold evidentiary hearings in making legal rulings. That a court may inquire beyond the document in interpreting a patent, including opinions of experts ⁸ as to the understanding of terms in a particular art, does not convert an issue for the court into an issue for the jury.

With respect to patent claims, it developed that in some instances judges found it useful to consult experts as to the proper understanding of technical terminology. However, they were not obliged to do so. The leading case is *Winans v. New York & E.R.R.*, 21 How. 88 (1859), decided only five years after *Winans v. Denmead*. The trial court had rejected a proffer of expert testimony to show the meaning of the terms of the patent. This Court affirmed because

"There was in fact but one question to be decided by the court, viz: the construction of the patent; the question of novelty being the fact to be passed on by the jury.

"The testimony of experts which was rejected had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent."

⁸ The information that a court may consult to assist in construing terms of a patent claim may include expert opinion testimony. Testimony of patentees is held to be of little probative value. See, e.g., *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1577 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1645 (1994). Expert opinion testimony is a form of evidence particularly subject to judicial control, and trial judges have considerable discretion whether to allow it at all. See Fed. R. Evid. 701-703; *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786 (1993).

21 How. at 100. This Court went on to explain:

"Experts may be examined to explain terms of art, and the state of the art, at any given time. . . . [B]ut professors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does not clearly comprehend, but cannot be compelled to receive their opinions as matter of evidence."

Id. at 100-01. A leading Nineteenth-Century treatise explained:

"As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases. The judges are not, however, obliged to blindly follow such testimony. They may disregard it if it appears to them to be unreasonable. While the testimony of experts relevant to the meaning of particular words or phrases in letters patent is to this extent admissible, such testimony is wholly inadmissible relevant to the construction of the letters patent as a whole."

A. WALKER, TEXT-BOOK OF THE PATENT LAWS 133-34 (1887) (footnotes omitted). See also 2 W. ROBINSON, *supra*, at 481; *Loom Co. v. Higgins*, 105 U.S. 580, 586 (1882) ("This evidence, of which the record in this case furnishes an abundance, being resorted to; we have no difficulty in comprehending the patent"). Courts continue to hear expert testimony when it is helpful to assist in construing technical language, while recognizing the distinction that "[i]nterpretation of language in patent claims is an issue of law . . . and the question whether a device literally infringes the claim as construed is one of fact." *In re Mahurkar Double Lumen*, 831 F. Supp. 1354, 1359 (N.D. Ill. 1993).

II. TRIAL BY JURY CONTEMPLATES A DIVISION OF FUNCTIONS BETWEEN JUDGE AND JURY.

Much of the dissent is devoted to establishing that the ultimate question of patent infringement was for the jury. *E.g.*, P. A. 118a-129a. But that is not contested here. The issue, rather, is allocation of function between judge and jury. Judges in order to make proper legal rulings often determine subsidiary issues of fact.

A. The Seventh Amendment Does Not Assign All Rulings Involving Factual Issues to the Jury.

"[F]actfinding . . . was never the exclusive province of the jury under either the English or American legal systems at the time of the adoption of the Seventh Amendment" *Atlas Roofing Co. v. OSHA*, 430 U.S. 442, 458 (1977). "[I]t is not 'trial by jury,' but 'the right of trial by jury,' which the Amendment declares 'shall be preserved.'" *Capital Traction Co. v. Hof*, 174 U.S. 1, 23 (1899). "[T]he Framers of the Seventh Amendment were concerned with preserving the *right* of trial by jury in civil cases where it existed at common law, rather than the various incidents of trial by jury." *Colgrove v. Battin*, 413 U.S. 149, 155-56 (1973) (emphasis in original; footnote omitted).

The right of trial by jury is the right to a trial conducted before a judge and a jury, in which each performs their respective customary functions. "Courts pass upon a vast number of questions of fact [T]here is not, and never was, any such thing in jury trials as an allotting of all questions of fact to the jury. The jury simply decides *some* questions of fact." J. THAYER, A PRELIMINARY TREATISE ON EVIDENCE 185 (1898), quoted in 9 J. WIGMORE, EVIDENCE 640 (J. Chadbourn rev. ed. 1981) (emphasis supplied). The "seventh amendment question depends on the nature of the issue to be tried rather than the character of the overall action." *Ross v. Bernhard*, 396 U.S. 531, 538 (1970).

The judge's function often requires the evaluation of factual testimony and the resolution of factual disputes

ancillary to the taking of evidence by the jury. Common examples are evidentiary hearings in criminal cases after which the court resolves motions to suppress evidence. In civil actions, evidentiary hearings are conducted by the court to resolve many factual disputes. Thus, for example,

“when the competency of a piece of evidence depends upon a preliminary fact, that fact is for the judge to decide. That means he is to decide it finally without submitting it to the jury.”

9 J. Wigmore, *supra*, at 641. And in doing so, the judge “may of course *hear evidence on both sides* for determining the facts on which the rule of admissibility turns.” *Id.* 663 (emphasis in original). The qualifications and knowledge of a witness are “a preliminary question for the judge presiding at the trial.” *Stillwell & Bierce Mfg. Co. v. Phelps*, 130 U.S. 520, 527 (1889); accord, e.g., *Spring Co. v. Edgar*, 99 U.S. 645, 658 (1879). In *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786 (1993), this Court mandated that under Fed. R. Evid. 104(a) and 702 “the trial judge must ensure that any and all scientific testimony or evidence admitted is not only relevant, but reliable.” 113 S. Ct. at 2795.⁹ See also Fed. R. Evid. 201 (judicial notice of adjudicative facts); Fed. R. Evid. 403 (judge may exclude probative evidence likely to mislead); Fed. R. Evid. 1008 (when admissibility “depends upon the fulfillment of a condition of fact, the question whether the condition has been fulfilled is ordinarily for the court to determine”); Fed. R. Civ. P. 23(b)(3) (findings on class certification). Cf. *Hurley v.*

⁹ See, e.g., *In re Paoli R.R. Yard PCB Litigation*, 35 F.3d 717, 736 (3d Cir. 1994) (five-day evidentiary hearing before judge on whether testimony satisfied Rule 702), *cert. denied sub nom. General Elec. Co. v. Ingram*, 115 S. Ct. 1253 (1995); *In re Japanese Electronic Prods. Antitrust Litigation*, 723 F.2d 238, 277 (3d Cir. 1983) (“as a matter of law, the district court must make a factual inquiry and finding as to what data experts in the field find reliable”), *reversed on other grounds sub nom. Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574 (1986).

Irish-American Gay, Lesbian & Bisexual Group, 115 S. Ct. 2338, 2344 (1995) (“constitutional facts”), citing *Fiske v. Kansas*, 274 U.S. 300, 305-06 (1927); see also *Bose Corp. v. Consumers Union of the United States, Inc.*, 466 U.S. 485, 511 (1984).

It will not do, as petitioners appear to believe, simply to call the right to jury trial “sacred,” Pet. Br. 21, and cite opinions like *Dimick v. Schiedt*, 293 U.S. 474 (1935), that have quite appropriately praised the right to jury trial preserved in the Seventh Amendment. For a jury trial without a judge performing his or her role would be neither sacred, nor what the Seventh Amendment preserves. *Hepner v. United States*, 213 U.S. 103, 115 (1909). To rely on such general observations simply begs the question, which is, what if any is the assignment of respective functions as to patent-claim construction that the right preserves? Even *Dimick v. Schiedt*, which held that additur by the court to damages awards was not permitted under the Seventh Amendment, was a decision in which Justice Stone, joined by Chief Justice Hughes and Justices Brandeis and Cardozo, dissented, citing examples of variations from procedures known in 1791 that the Court had approved, such as remittitur. See 293 U.S. at 491-92, 495; *Arkansas Valley Land & Cattle Co. v. Mann*, 130 U.S. 69, 72-74 (1889).¹⁰

Scarcely mentioned by petitioners is *Galloway v. United States*, 319 U.S. 372 (1943). There this Court explained that “[t]he jury was not absolute master of fact in 1791,” pointing out as examples the court’s authority to exclude evidence for privileges or irrelevancy, to direct verdicts, and to set aside verdicts for insufficient evidence.

“The [Seventh] Amendment did not bind the federal courts to the exact procedural incidents or de-

¹⁰ E.g., *Ex parte Peterson*, 253 U.S. 309 (1920) (auditors to report on facts); *Walker v. New Mexico & S.P.R.R.*, 165 U.S. 593 (1897) (special verdict); *Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494 (1931) (new trial on damages); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) (summary judgment).

tails of the jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing."

319 U.S. at 390 (footnote omitted) (citing dissent of Stone, J., in *Dimick v. Schiedt*, *supra*). "[T]he Amendment was designed to preserve the basic institution of jury trial in only its most fundamental elements, not the great mass of procedural forms and details, varying even then so widely among common-law jurisdictions." 319 U.S. at 392 (footnote omitted). "[M]any procedural devices developed since 1791 that have diminished the civil jury's historic domain have been found not to be inconsistent with the Seventh Amendment." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 336 (1979); see also *id.* at 345 (Rehnquist, J. dissenting) ("it is the substance of the right of jury trial that is preserved, not the incidental or collateral effects of common-law practice in 1791"). Cf. Fed. R. Evid. 102 ("These rules shall be construed to secure . . . promotion of growth and development of the law of evidence").¹¹

There are, of course, certain issues in patent cases that if materially disputed are for the jury. Infringement—whether one product actually transgresses the area pa-

¹¹ See also *Gasoline Prods. Co. v. Champlin Ref. Co.*, *supra*, 283 U.S. at 497-98 ("It is true that at common law there was no practice of setting aside a verdict in part" but "the Constitution is concerned not with form, but with substance"); *Fidelity & Deposit Co. v. United States*, 187 U.S. 315, 320-21 (1902). "The command of the Seventh Amendment that 'the right of trial by jury shall be preserved' does not require that old forms of practice and procedure be retained." *Ex parte Peterson*, *supra*, 253 U.S. at 309 (Brandeis, J.). The development of trial by jury "surely . . . was not, by the adoption of our constitutions, suddenly congealed." Scott, *Trial by Jury and the Reform of Civil Procedure*, 31 HARV. L. REV. 669, 670 (1918). "Only those incidents which are regarded as fundamental, as inherent in and of the essence of the system of trial by jury, are placed beyond the reach of the legislature." *Id.* at 671, quoted in *Tull v. United States*, 481 U.S. 412, 426 (1987), and *Colgrove v. Battin*, 413 U.S. 149, 156 n.11 (1973). *Accord*, *Galloway v. United States*, *supra*, 319 U.S. at 392.

tented to another; "equivalence"—whether a product although not identical is essentially the same as what was patented; "enablement"—whether a person skilled in the art could look at a patent and build the invention. But construing the meaning of the claims stated in the patent itself has for over a century been recognized as a legal determination for the court.

Searching for authority, petitioners unfortunately commingle all sorts of Nineteenth-Century patent decisions, citing some that involved such jury issues. Pet. Br. 31-34. Lack of inventiveness, for example, was the issue in *Tucker v. Spalding*, 13 Wall. 453 (1872); see 3 W. ROBINSON, *supra*, at 373 n.1. *Market Street Cable Ry. v. Rowley*, 155 U.S. 621 (1895), and *Bischoff v. Wethered*, 9 Wall. 812 (1870), involved the jury issue of novelty; see 3 W. ROBINSON, *supra*, at 375 n.5. The jury also sometimes decided whether a reissued patent was identical to the original. Cf. *Heald v. Rice*, 104 U.S. 737 (1882).

That in some cases construction of a patent claim may be outcome-determinative, as petitioners urge, Br. 17-18, does not advance their argument.¹² Legal rulings by definition often are. Cf. Fed. R. Civ. P. 12(b)(6). "The rules governing the admissibility of evidence, for example, have a real impact on the jury's function as a trier of facts and the judge's power to impinge on that function." *Galloway v. United States*, *supra*, 319 U.S. at 390 n.22. So does the court's authority to take fact issues from the jury if evidence is insufficient. *Improvement Co. v. Munson*, 14 Wall. 442, 447 (1872); see also *Gunning v. Cooley*, 281 U.S. 90 (1930). And "[t]he power of the court to grant a new trial if in its judgment the jury have misinterpreted the instructions as to the rules of law or misapplied them is unquestioned, as also when it appears

¹² An *amicus* goes so far as to argue that in jury cases "legally relevant questions of fact about which there is a genuine dispute are *always* subject to the jury-trial right . . . regardless of how the facts fit into, or mix with, the legal matrix of the overall controversy." Litton Br. 12 (emphasis in original).

that there was no real evidence in support of any essential fact." *Walker v. New Mexico & S.P.R.R.*, 165 U.S. 593, 596 (1897).

The invocation of the "reexamination" clause, Litton Br. at 12-13, is chimerical. As the construction of a claim is for the court, there is no factfinding by the jury to be reexamined. In the present case, the trial court provisionally allowed the interpretation to be made by the jury, then corrected itself and determined the issue as a matter of law. In substance, a legal ruling was reserved. That in no way involves the Seventh Amendment's concern about judges or appellate courts overturning jury verdicts, any more than would an appellate court's reviewing for error of law. Also, the clause forbids only reexamination "otherwise . . . than according to the rules of the common law."

"At common law there was a well established practice of reserving questions of law arising during trials by jury and of taking verdicts subject to the ultimate ruling on the questions reserved [I]t undoubtedly was well established when the Seventh Amendment was adopted, and therefore must be regarded as part of the common-law rules, to which resort must be had"

Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 659-60 (1935).

B. Judges, Not Juries, Construe Official Grants and Directives.

1. *Public Laws*.—Patents are grants that bind the public.¹³ *Wheaton v. Peters*, 8 Pet. 591, 663-64 (1834). "Like other statutes, those which confer legal advantages or economic benefits have all the force, effects and attributes of laws. They are subject to the same rules of interpretation that apply to other statutes." 3 SUTHERLAND STATUTORY CONSTRUCTION 228 (N. Singer rev. ed.

¹³ "The King's grants are contained in charters or letters patent, . . . with the great seal pendent at the bottom, and are usually directed or addressed by the King to all his subjects at large." W. HANDS, LAW AND PRACTICE OF PATENTS FOR INVENTIONS 1 (1808).

1992) (footnote omitted). "[G]rants provided for . . . patents protecting inventions" are among these. *Id.* at 238. It is for courts, of course, to construe statutes using whatever materials seem useful. *E.g.*, *NLRB v. Town & Country Electric, Inc.*, 64 U.S.L.W. 4022, 4024 (1995) (referring to dictionaries); *Bailey v. United States*, No. 94-7448 (Dec. 6, 1995), slip op. at 8 (same).

2. *Private Laws*.—Like a private relief act, a patent assigns a governmentally owned right to a private person, using the intermediary of the Patent Office to designate the terms and scope of the grant. See *United States v. American Bell Tel. Co.*, 128 U.S. 315, 360-63 (1888). Indeed, "[s]pecial acts for the relief of particular inventors have often been passed by congress," *The Fire-Extinguisher Case*, 21 Fed. 40, 42 (C.C.D. Md. 1884), and construed by courts like any other laws. *E.g.*, *Evans v. Eaton*, 3 Wheat. 454, 517 (1818) (construing patent granted under private act, 6 Stat. 70; *cf.* *Great N. Ry. v. United States*, 315 U.S. 262, 273 (1942) (construing land grant in light of historical facts)).

3. *Patents for Land*.—Invention patents are only one example of grants from the sovereign of exclusive rights. Millions of acres of public lands have been patented to individuals and corporations by the federal and state governments. "The power . . . to issue a patent for an invention, and the authority to issue such an instrument for a grant of land, emanate from the same source, and . . . are of the same nature, character and validity" *United States v. American Bell Tel. Co.*, *supra*, 128 U.S. at 358-59. Land patents, this Court has held, like patents for inventions are for the judge to construe as a matter of law, while juries decide whether the boundaries of the claim as construed by the court have in fact been transgressed. In *Brown v. Huger*, 21 How. 305 (1859), this Court held:

"With regard to the second part of this objection, that which claims for the jury the construction of the patent, we remark that the patent itself must be taken as evidence of its meaning; that, like other written

instruments, it must be interpreted as a whole, its various provisions be taken as far as practicable in connection with each other, and the legal deductions drawn therefrom must be conformable with the scope and purpose of the entire document. *This construction and these deductions we hold to be within the exclusive province of the court.* The patent itself could not be altered by evidence aliunde, but proof as to the existence and character of the objects or subjects to which it was applicable was regular, and even necessary to give it effect."

21 How. at 318 (emphasis supplied). Although a land claim that rested upon testimony as to markers could be for a jury, *id.* at 320-21, construction of a land patent is "a question of law," *id.* at 319, and a claim under a patent simply "presents for the determination of the court the construction of the calls for boundary mentioned in the patent, and surely none will pretend that the legal construction of a patent is not a matter proper for the decision of a court." *Id.* at 321.¹⁴

4. *Copyrights.*—The determination of what material is included in a copyright is for the court, not a jury. Copyrights, like patents, are public grants and have boundaries. A copyright grant covers only the "constituent elements of the work that are original," and it is a legal question for the court whether, for example, "Rural's white pages lack the requisite originality." *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 364 (1991); accord, *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548 (1985). Thus although "[d]etermining which elements of a [computer] program are protectable is a difficult task," nevertheless there is no doubt that "a court should dissect the program" in order to do so. *Gates Rubber Co. v. Bando Chem. Industries, Ltd.*, 9 F.3d 823,

¹⁴ *Reed v. Proprietors of Locks*, 8 How. 274 (1850), a case involving not a land patent but a private deed, is incompletely described at Litton Br. 21. This Court held that "it was the duty of the court to give a construction to the deed in question, so far as the intention of the parties could be elicited therefrom," 8 How. at 288, as under the parol evidence rule, which assigns contract interpretation to the court. See 8 How. at 290.

834 (10th Cir. 1993); accord, e.g., *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207 (9th Cir. 1989) ("these instructions did not adequately explain to the jury which material was, in fact, protectable").

5. *Corporate Charters.*—Corporate charters are construed by courts, not juries. "It is the duty of the court to ascertain by a fair, intelligent and equitable construction of the language used what is the character and extent of the grant." 7A W. FLETCHER, CYCLOPEDIA OF PRIVATE CORPORATIONS 242 (Keating & Nelson rev. ed. 1989). This Court indeed has noted that "The rule of construction in this class of cases is that it shall be most strongly against the corporation." *Fertilizing Co. v. Hyde Park*, 97 U.S. 659, 666 (1878); see also *Proprietors of Charles River Bridge v. Proprietors of Warren Bridge*, 11 Pet. 420, 538-39, 548 (1837) (construing charter as not excluding competition); cf. *Trustees of Dartmouth College v. Woodward*, 4 Wheat. 518, 629 (1819) (construing charter). The same rule applies to charters of municipal corporations. *Driggins v. Oklahoma City*, 954 F.2d 1511, 1513 (10th Cir.), cert. denied, 113 S. Ct. 129 (1992).

6. *Federal Regulations.*—Federal regulations often contain terms that may require technical knowledge to interpret. But that does not mean that the interpretation of such regulations is handed over to a jury, nor that judges are precluded from consulting extrinsic aids to understand them. See, e.g., *Nippon Kogaku (USA), Inc. v. United States*, 673 F.2d 380, 383 (C.C.P.A. 1982) (construction of tariff schedules); *United States v. Boeing Co.*, 802 F.2d 1390, 1393 (Fed. Cir. 1986) (construction of federal acquisition regulations); *United States v. Weitzenhoff*, 1 F.3d 1523, 1531-32 (9th Cir. 1993) (error to submit to jury expert testimony on construction of "removed substance" and "essential maintenance" in EPA regulation), cert. denied sub nom. *Mariani v. United States*, 115 S. Ct. 939 (1995).

7. *Foreign Law.*—Although "[i]t was generally held at common law that a foreign law is a matter of 'fact,'

i.e., its existence is to be determined by the jury," nevertheless "the only sound view, either on principle or on policy, is that it should be proved to the judge." 9 J. WIGMORE, EVIDENCE 687 (J. Chadbourn rev. ed. 1981) (emphasis in original). Under Fed. R. Civ. P. 44.1, courts determine foreign law and in doing so "have turned to a wide variety of sources including affidavits and expert testimony." *United States v. Mitchell*, 985 F.2d 1275, 1280 (4th Cir. 1993) (Fed. R. Crim. P. 26.1); see generally Miller, *Federal Rule 44.1 and the "Fact" Approach to Determining Foreign Law*, 65 MICH. L. REV. 613, 684 (1967) ("No federal case involving foreign law has been found in which the jury-trial question was considered to be of constitutional dimensions").

8. *Consent Orders*.—"[C]onstruing the meaning of a consent order, even an ambiguous one, is a question of law for the court" *United States v. Reader's Digest Ass'n*, 662 F.2d 955, 961 (3d Cir. 1981), cert. denied, 455 U.S. 908 (1982). The court may consult materials outside the order in construing it. *Id.*; see also, e.g., *United States v. J.B. Williams Co.*, 498 F.2d 414, 430-31 (2d Cir. 1974) (distinguishing what an order means (for court) from whether it has been violated (for jury)).

9. *Collateral Estoppel*.—The doctrine of collateral estoppel applies to patent litigation, and judges determine which fact issues are thereby precluded from jury consideration without regard to common-law doctrines of mutuality. *Blonder-Tongue Labs., Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971); see also *Parklane Hosiery Co. v. Shore*, *supra*.

10. *Private Agreements Distinguished*.—It is not accurate to say that "this Court has held that patents are properly analogous to contracts or deeds, not to statutes." Litton Br. 4. This Court has held no such thing; and the principles applied to private agreements are different.¹⁵

¹⁵ In *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880), cited at Litton Br. 20 n.32, this Court on review construed the patent, referring to the evidence. *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917), does not

Even contract cases start with the parol evidence rule—that construction of the document is for the court—which at the turn of the Nineteenth Century was taken seriously. See, e.g., *Levy v. Gadsby*, 3 Cranch 180, 186 (1805) ("no principle is more clearly settled, than that the construction of a written evidence is exclusively with the court"). Only if there is ambiguity can parol evidence be presented, and then only for the limited purpose of trying to determine what the parties intended.

A patent is not a contract negotiated by the patentee. Nor are private contracts required by law to be clear, as patents are. Since the Patent Act of 1836, patent examiners have been established as an administrative assurance that the grant conforms to legal requirements, "for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture." *Keystone Bridge Co. v. Phoenix Iron Co.*, *supra*, 95 U.S. at 278; see also *Corning v. Burden*, 15 How. 252, 270-71 (1854). Being the result of this administrative screening, patents and their claims are presumed valid; claim interpretation is in effect a review of an agency determination. Cf. *Mitchell v. Tilghman*, 19 Wall. 287, 390 (1874).

Petitioners' argument that patents should be treated like private contracts because they can be viewed as "bargains" with society is little more than a play on words. Pet. Br. 44. The policy underlying patents can be likened to a theoretical bargain between the government and inventors generally, to provide limited monopolies in order that the public may benefit from disclosure of their work. See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989). That analytical rationalization in no way assumes that individual inventors are allowed to bargain about the terms of their patents. Nor

likened a patent to a deed, and at the page cited at Litton Br. 21 n.33 reiterates that "It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is." 243 U.S. at 510.

does it imply that juries should define the terms of the government's grant.¹⁶

C. Standard of Appellate Review Is a Separate Question.

The instances inviting resort to technical expert testimony to assist the court in construing a patent claim are far less frequent than petitioners imply. Most patents can be interpreted without resort to extrinsic aids, just as most statutes can be interpreted without resort to legislative materials.¹⁷ This Court and others often have construed patent claims on appellate review without expressing any need for assistance from outside experts. *E.g.*, *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942). As a general rule "appellate courts have untrammelled power to interpret written documents." *Eddy v. Prudence Bonds Corp.*, 165 F.2d 157, 163 (2d Cir. 1947) (L. Hand, J.), *cert. denied sub nom. Prudence Realization Corp. v. Eddy*, 333 U.S. 845 (1948).

¹⁶ There is no basis for imposing on the law a new distinction between "construction" and "interpretation" of a patent claim, as proposed by the dissent at P.C.A. 87a-89a. The cases do not recognize it, and it would make no difference: "The interpretation, as well as the construction of a written instrument, is for the Court, and not for the Jury." 1 S. GREENLEAF, EVIDENCE 400 n.1 (3d ed. 1846); see also P.C.A. 21a n.6. And it is difficult to comprehend *amicus'* plainly incorrect assertion that private contracts are somehow "enforceable against the public," Litton Br. 19, or the proposition, citing *Shelly v. Kraemer*, 334 U.S. 1 (1948), that private contracts somehow are really public instruments. Litton Br. at 20 n.29.

¹⁷ See, *e.g.*, Rifkind, *The Romance Discoverable in Patent Cases*, 16 F.R.D. 253, 254 (1954) ("I fail to see why the technical intricacies of a patent should be harder to understand than the complexities of a corporate merger or a family history"). "The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles. . . ." *Hogg v. Emerson*, 6 How. 437, 485 (1848). *Cf. Smith v. Snow*, *supra* (construing claim for incubator). *Cf. also Burlington N.R.R. v. Oklahoma Tax Comm'n*, 481 U.S. 454, 461 (1987); *Diamond v. Diehr*, 450 U.S. 175, 182 (1981); *Rubin v. United States*, 449 U.S. 424, 430 (1981).

Constitutional policy points toward plenary appellate review of the scope of patent claims; for patent monopolies are not to be enlarged beyond the limited grants authorized by the Constitution. The Seventh Amendment's "ban on re-examination of facts does not preclude us from determining whether governing rules of federal law have been properly applied to the facts." *New York Times Co. v. Sullivan*, 376 U.S. 254, 285 n.26 (1964). Appropriately confining the scope of patent claims is at the heart of constitutional policy on patents. *E.g.*, *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).¹⁸

If in uncommon instances evaluation of expert testimony on claims might be thought to entail determinative credibility judgments based on demeanor, the model might be *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657 (1989). There in conducting appellate review of facts under *New York Times Co. v. Sullivan*, *supra*, this Court held that "credibility determinations are reviewed under the clearly-erroneous standard." 491 U.S. at 688. A similar analysis could apply to judicial factfinding collateral to interpretation of patent claims. *Cf. Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986) ("whether or not the ultimate question of obviousness is a question of fact subject to Rule 52(a), the subsidiary determinations of the District Court, at the least, ought to be subject to the Rule"); see also *Harries v. Air King Prods. Co.*, 183 F.2d 158, 164 (2d Cir. 1950). The standard of appellate review is a consideration quite distinct from that of whether judges are to continue to construe patent claims. See generally *First Options of Chicago, Inc. v. Kaplan*, 115 S. Ct. 1920, 1926 (1995); *Salve Regina College v. Russell*, 499 U.S. 225, 231-33 (1991).

¹⁸ "At least in those instances in which Congress has not spoken and in which the issue falls somewhere between a pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question." *Miller v. Fenton*, 474 U.S. 104, 114 (1985). *Cf. Parker v. Hulme*, *supra*.

III. HISTORY DOES NOT SUPPORT PETITIONERS' POSITION.

A. Juries Did Not Construe the Scope of Royal Patents in 1791.

Petitioners describe 1791 English law as "unequivocal," Pet. Br. 25, and assert that "the historical record shows that the issue here was a jury issue in 1791." *Id.* at 23. That is not remotely correct. Patent law in England at that time was scarcely describable. From 1750 to 1799 there were only 18 patent decisions at common law in England, and hardly any of those prior to the American Revolution. H. DUTTON, *THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION 1750-1852* at 78 (1984). The common-law courts did not receive general authority to hear patent cases until 1752, and "[t]he net result was considerable uncertainty as to the nature of the patent law," and "lack of adequate case law." Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents*, 77 J. PAT. & T. OFF. SOC'Y 771, 775-76 (1995).

"In the late eighteenth and early nineteenth centuries, when the law remained in an infant and unsettled state, judges rarely expressed a consistent viewpoint." H. DUTTON, *supra*, at 77. "The equity courts were rarely guided by precedent . . . [and] the common-law courts were no better." C. MACLEOD, *INVENTING THE INDUSTRIAL REVOLUTION* 61 (1988). An attorney in 1785 who asked "What is the Law of Patents?" reported "[t]he books are silent." Adams & Averly, *The Patent Specification: The Role of Liardet v. Johnson*, 7 J. LEGAL HIST. 156, 167 (1986). "Patent rights are no where that I can find accurately discussed in our books." *Boulton v. Bull*, 2 H. Bl. 463, 491, 126 Eng. Rep. 651, 655 (C.P. 1795) (Eyre, C.J.). "At the end of the eighteenth century . . . the Common Law judges were left to pick up the threads of the principles of law without the aid of recent and reliable precedents." Adams & Averly, *supra*, at 157. There was no coherent body of English patent law to be known by the enactors of the Seventh Amendment.

Eighteenth-Century English patents did not contain claims by the inventor; they required simply specifications of the invention. Thus the few English cases petitioners cite obviously did not involve jury construction of patent claims as such, for there were none to construe. Juries in infringement cases did decide whether specifications satisfied "enablement": whether the specification was detailed enough to enable someone to copy the invention, which was a common issue in early English patent cases. See F. BULLER, *TRIALS AT NISI PRIUS* 76*b* (7th ed. 1817). Each of the two reported pre-1791 cases that petitioners cite is of that kind. *Turner v. Winter*, 1 T.R. 602, 1 Rev. Rep. 311 (K.B. 1787); *Arkwright v. Nightingale*, Dav. Pat. Cas. 37 (C.P. 1785). So is the summary of a jury instruction in an unreported trial, *Liardet v. Johnson* (n.p. 1778).¹⁰ Post-1791 English cases cited by petitioners similarly were decisions on the issue of "enablement." *Hornblower v. Boulton*, 8 T.R. 95, 101 Eng. Rep. 1285 (K.B. 1799); *Huddart v. Grimshaw*, Dav. Pat. Cas. 265 (K.B.

¹⁰ *Liardet v. Johnson*, which petitioners incorrectly cite as "a leading King's Bench decision," Pet. Br. 23, was not a decision reviewed by the King's Bench. It was an unreported trial before Lord Mansfield, and was notable only for his instruction on novelty, an issue not involved here. See Hulme, *On the History of Patent Law*, 18 LAW Q. REV. 280, 287 (1902). Regarding the jury's role, it simply followed the accepted doctrine that the specification must enable a person skilled in the art to build the invention, which was a jury issue. The phrase quoted at Pet. Br. 24 is not from the trial but from later editions of a treatise by Sir Francis Buller. "Buller's *Nisi Prius* in fact incorrectly records the outcome. His version is evidently based on the defendant's pamphlet." Adams & Averly, *supra*, 7 J. LEGAL HIST. at 165 (footnote omitted); see F. BULLER, *TRIALS AT NISI PRIUS* 76*b* (7th ed. 1817). Buller's manuscript notes of the charge, presumably based on the pamphlet, do not contain any instruction that the jury construe the patent. In their entirety they read:

"[Lord Mansfield] left to the jury 1st, on all objections made to exactness, certainty and propriety of the Specifications, & whether any workman could make it by [the Specification]."

I J. OLDHAM, *THE MANSFIELD MANUSCRIPTS* 756 (1992) (brackets in original). See also *Boulton v. Bull*, *supra*, 2 H. Bl. at 491, 126 Eng. Rep. at 665: "The modern cases have chiefly turned upon the specifications, whether there was a fair disclosure."

1803); *Bovill v. Moore*, Dav. Pat. Cas. 361, 17 Rev. Rep. 514 (C.P. 1816).

By the early Nineteenth Century, English judges were not hesitating to construe patent specifications (there being no claims). See *Russell v. Cowley*, Web. Pat. Cas. 457, 465, 468-70 (Exch. 1834); *Haworth v. Hardcastle*, Web. Pat. Cas. 480, 483, 484 (1834). Petitioners seek support in a case decided in England fifty years after the Seventh Amendment, *Neilson v. Harford*, 8 M. & W. 806, 151 Eng. Rep. 1266, Web. Pat. Cas. 331 (Exch. 1841), but they misunderstand it. Petitioners say, Br. 27, that "The *Neilson* court agreed that it was 'peculiarly the province of a jury' to construe 'as matters of fact' patent terms that might constitute 'words of art, words of commerce, [and] words which are used in some sense different from their ordinary sense.'" But what petitioners quote is not the court at all, but rather oral argument of counsel. See Web. Pat. Cas. at 367. The report shows that one judge interrupted the argument to observe:

"You are proposing to leave to the jury the construction of that which limits the amount of the right of the patentee as regards all subsequent inventions. To what an extravagant length that goes."

Id. Another judge also interrupted to explain that the jury's function was not to decide the limits of the patent, but rather "The question, whether a patent is so worded as that a person of ordinary knowledge will understand it and work by it, is for the jury." *Id.* He observed:

"It appears to me to be too late at the present day to contend that it is not for the Court to construe the specification, like any other written instrument."

8 M. & W. at 823, 151 Eng. Rep. at 1273. The court's opinion concluded that although the jury in performing its function of determining "enablement" could ascertain the meaning of terms of art,

"Then we come to the question itself, which depends on the proper construction to be put on the specification itself. It was contended, that of this

construction the jury were to judge. We are clearly of a different opinion."

Id. at 370, 8 M. & W. at 823, 151 Eng. Rep. at 1273. *Neilson v. Harford* is cited by English legal scholars as holding that "The construction of the specification is for the court alone." TERRELL ON THE LAW OF PATENTS 73 (W. Aldous, et al., 13th ed. 1982).²⁰

B. United States Patent Law Requires Clarity and Predictability of Patent Claims.

Claims were not a part of American patents at the beginning, either, so analogies cannot be perfect.²¹ But Congress from the first patent law insisted that inventors describe their inventions with clarity, in a manner understandable not only to persons skilled in the art, but also by the administrators of the patent system, and by the public, which was paying the burden of the granted monopoly. Unlike grants from the crown, patents in this country had to comply with a constitutional provision. U.S. Const., Art. I, § 8, cl. 8. The first patent act in 1790, older

²⁰ Cf. 1 W. CARPMAEL, LAW REPORTS OF PATENT CASES iv (1843) (publishing collection of patent decisions "to give a correct opinion of the construction which a court of law will put on a particular specification").

²¹ "Nor were 'the rules of the common law' then prevalent, including those relating to the procedure by which the judge regulated the jury's role on questions of fact, crystallized in a fixed and immutable system." *Galloway v. United States*, 319 U.S. 372, 390-91 (1943). Members of this Court have observed that "the incompleteness of our historical records makes it difficult to know the nature of certain actions in 1791." *Chauffeurs Local No. 391 v. Terry*, 494 U.S. 558, 593 (1990) (Kennedy, J., dissenting); *id.* at 576 (Brennan, J., concurring) (referring to "recondite controversies better left to legal historians"). "Neither during the ratification controversy nor in the subsequent proceedings on adoption of the Bill of Rights was any specific consensus expressed on the relation of judge to jury in civil cases," and there was "great diversity of practice in the thirteen states." Henderson, *The Background of the Seventh Amendment*, 80 HARV. L. REV. 289, 336 (1966). But "uniform postratification practice can shed light upon the meaning of an ambiguous constitutional provision." *United States v. Gaudin*, 115 S. Ct. 2310, 2318 (1995).

than the Seventh Amendment, required filing of a specification "so particular," and if feasible a model of the invention "so exact," that it could be distinguished from the prior art and that a skilled person could replicate it "to the end that the public may have the full benefit thereof, after the expiration of the patent term."²²

It became the practice in the United States (unlike the old English law, for patent applications to include not just specifications of the device, but also "claims" defining the aspects in which it was novel and therefore entitled to be patented. The inclusion of claims became mandatory beginning with the Patent Act of 1836, Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119. See Schneider, *Claims to Fame*, 71 J. PAT. & T. OFF. SOC'Y 143, 145 (1989). And the Patent Act of 1870 tightened the law further by requiring that the application "particularly point out and distinctly claim" the invention. Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198, 201. "The claims 'measure the invention.'" *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938), quoting in part *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908).

In *Hogg v. Emerson*, 6 How. 437 (1848), this Court in ruling "without the aid of experts and machinists" noted that exactness was required not only to enable a person skilled in the art to make the device, but also so the Commissioner of Patents could decide whether it qualified, and also to allow "the public" to understand precisely what was patented. 6 How. at 484; see also *Winans v. Denmead*, *supra*, 15 How. at 342-44; *Blake v. Stafford*, 3 Fed. Cas. 610, 612-13 (C.C.D. Conn. 1868) (No. 1,504) ("The office of the claim is to define the limits of the patented discovery claimed by the patentee as his exclusive property. . . . If, by the use of good sense, and the ordinary rules of interpretation, the court can clearly see the nature and limits of the invention, the claim will be upheld").

²² Act of April 10, 1790, ch. 7, § 2, 1 Stat. 109, 110. See also Act of Feb. 21, 1793, ch. 11, § 3, 1 Stat. 318, 321 ("a written description of his invention . . . in . . . full, clear and exact terms").

"The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further."

White v. Dunbar, 119 U.S. 47, 52 (1886); see also *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 435-37 (1902) (distinguishing claim from specification, which "is not addressed to lawyers, or even to the public generally"). Thus the current statute, 35 U.S.C. § 112, addresses the specification to "any person skilled in the art," but the claim required is not so limited.

IV. CONSTITUTIONAL POLICY REQUIRES PATENT CERTAINTY.

A. Patents Are Constitutionally Limited.

Just as "[t]he primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts,'" *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991), so the dominant interest in patents is the public's. As with copyrights, "[t]he sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public" *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932). "[F]ree exploitation of ideas will be the rule, to which the protection of a federal patent is the exception." *Bonito Boats*, *supra*, 489 U.S. at 151; see also *id.* at 147-48. The respective responsibilities of court and jury in infringement suits can be informed by recognizing that although infringement suits usually arise between private parties, patents themselves may be viewed as "public rights." See *In re Lockwood*, 50 F.3d 966, 981 (Fed. Cir.) (Nies, J., dissenting), *vacated sub nom. American Airlines, Inc. v. Lockwood*, 116 S. Ct. 29 (1995).²³

²³ "[T]he grant of a valid patent is primarily a public concern." *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604, *rehearing denied*,

Patent disputes could, if Congress chose, be assigned for resolution to an Article I court or an administrative agency, with appropriate judicial review, because "[t]he Seventh Amendment protects a litigant's right to a jury trial only if a cause of action is legal in nature and it involves a matter of 'private right.'" *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 n.4 (1989); see also *Wickwire v. Reinecke*, 275 U.S. 101, 105-06 (1927); *Mountain Timber Co. v. Washington*, 243 U.S. 219, 235 (1917). Congress instead has chosen to authorize legal actions for infringement and assign them to Article III courts, thus assuring the parties in infringement actions the right of jury trial. But in determining the assignment of issues between court and jury it is appropriate to bear in mind the "public" nature of the underlying patent right, and the public importance of proper construction of patent claims. See, e.g., *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147 (1950).

B. Certainty Is Required in Patent Claims.

Certainty in patent claims is more than a convenience. It serves a constitutional purpose. "From their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy." *Bonito Boats, supra*, 489 U.S. at 146. Congress is not allowed to "enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby." *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966). Yet the patent monopoly is broadened if a patentee can come in later and argue to a jury that the claim is broader than a court would understand the claim language to mean.

771 F.2d 480, 481 (Fed. Cir. 1985). "The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights." *Merrill v. Yeomans*, 94 U.S. 568, 573 (1877).

Jury interpretation of claims would mean that every patent granted, instead of fixing the patentee's claim in the document, would be surrounded by an uncertain penumbra of what one or another jury might decide was meant by words in a patent. And each of those jury verdicts, however inconsistent, would not be subject to review for error of law. Claims would lack clear boundaries, and new inventions would be chilled by the fear that a jury might be persuaded to misinterpret an earlier patent's claim.

"[I]f the public comes to believe (or fear) that the language of patent claims can never be relied on . . . then claims will cease to serve their intended purpose. Competitors will never know whether their actions infringe a granted patent."

London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed. Cir. 1991).²⁴ The scope of a patent,

"If it may be shown by parol evidence to the jury, as the plaintiff's counsel contend it may, then it may be fairly asked, cui bono? . . . As to the public at large . . . the evidence given in this cause, must be evanescent, and totally useless."

Evans v. Eaton, 8 Fed. Cas. 856, 860 (C.C.D. Pa. 1818) (No. 4,560) (Washington, J.), *aff'd*, 7 Wheat. 356 (1822); see also *Evans v. Hettick*, 8 Fed. Cas. 861, 868 (C.C.E.D. Pa. 1818) (No. 4,562), *aff'd*, 7 Wheat. 453 (1822); *Dixon v. Moyer*, 7 Fed. Cas. 758, 760 (C.C.D. Pa. 1821) (No. 3,931) (Washington, J.) (observing that "[i]t is not enough . . . to point out at the trial" what a patent means, because "[t]hird persons . . . can safely depend upon no other information that what the records of the secretary of state's office may afford"). Construction must be for the court because

²⁴ In 1968-70, only 13 of the 382 patent cases were jury trials. See *Blonder-Tongue Labs., Inc. v. University of Illinois Foundation*, 402 U.S. 313, 336 n.30 (1971). By 1994 the figure had risen to 70%. *In re Lockwood, supra*, 50 F.3d at 980 n.1 (Nies, J., dissenting).

"Unless this were so, there would be no certainty in the law, for a misconstruction by the court is the proper subject, by means of a bill of exceptions, of redress in a court of error, but a misconstruction by the jury cannot be set right at all effectually."

Neilson v. Harford, *supra*, Web. Pat. Cas. at 370. Cf. *United States v. Turner*, 11 How. 663, 668 (1850) (construction of land titles is for the court because "the titles to land in that State would become unstable and insecure . . . [if dependent on] the fluctuating verdicts of juries").

The Patent Clause anticipated a uniformity in patent policy. See *Bonito Boats*, *supra*, 489 U.S. at 156-57. "The Need for Increased Uniformity in Patent Law" was emphasized by the Congress as a major reason for establishing the Court of Appeals for the Federal Circuit. H.R. Rep. No. 97-312, 97th Cong., 1st Sess. 20 (1981). The Federal Circuit has been charged with developing a body of law to guide courts and provide consistency in claim construction.²⁵

Petitioners have history and precedent overwhelmingly against them. Their new interpretation of the Seventh Amendment would not only declare two centuries of practice unconstitutional. In addition, it would undermine the constitutional policy of the Patent Clause so severely that this is yet another instance in which "the consequences flowing from the view asserted are sufficient to refute it." *Galloway v. United States*, *supra*, 319 U.S. at 392.

CONCLUSION

For the reasons stated, the judgment should be affirmed, and the judgment in No. 94-2081 vacated and remanded.

²⁵ As of this week 30 district courts have issued opinions applying the Federal Circuit's decision here. None has expressed the slightest difficulty or dismay except the District of Delaware, whose criticism centered on the standard of appellate review. See Pet. Br. 48-49.

Respectfully submitted,

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December 8, 1995